

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re application of** : **April 30, 2006**  
**S. Ravikumar et al.**  
**Group Art Unit: 2174** : **Examiner: Ryan F. Pitaro**  
**Serial No.: 10/035,999** : **Filed: 12/31/2001**  
**Attorney Docket: ARC9-2001-0121-US1** : **Confirmation No.: 2455**  
**Title: GRAPHICAL USER INTERFACE TOOLS FOR SPECIFYING**  
**PREFERENCES IN E-COMMERCE APPLICATIONS**

**APPEAL BRIEF**

**Commissioner of Patents and Trademarks**

**Sir:**

**This brief is submitted under 35 U.S.C. 134 and is in accordance with 37 C.F.R. Parts 1, 5, 10, 11, and 41, effective September 13, 2004 and published at 60 Fed. Reg. 155 (August 2004). This brief is further to Appellant's Notice of Appeal previously filed.**

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**10/035,999 ARC9-2001-0121-US1**

**(1) Real Party in Interest**

**The real party in interest is the IBM Corporation.**

**(2) Related Appeals/Interferences**

**No other appeals or interferences exist which relate to the present application or appeal.**

**(3) Status of Claims**

**Claims 1-7, 9, and 14-17 are pending and finally rejected. The other claims are canceled.**

**(4) Status of Amendments**

**No amendments are outstanding.**

**(5) Summary of Claimed Subject Matter**

**As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.**

**Claim 1 teaches a method for specifying user preferences, comprising generating a pull-down menu in a graphical user interface, and enabling a user to move labeled items in the pull-down menu representing user choices describing**

**variables in electronic commerce transactions such that relative positions of said items correspond to relative user preferences. See for example page 1 lines 6-9 of the specification. Claims 6, 16, and 17 are similar, differing essentially only in form and the use of an input device (page 4 lines 13-14).**

**Dependent claims 2 and 3 describe the further limitations of enabling a user to delete labeled items that are unacceptable or uninteresting user choices (page 4 line 10, page 6 line 20 to page 7 line 1). Dependent claim 4 describes the further limitation of enabling a user to limit the number of labeled items being processed by using a cut-off bar (page 4 lines 10-11, page 7 lines 4-6). Dependent claim 5 describes the further limitation of moving the labeled items by clicking and dragging (page 4 line 7, page 8 lines 12-13).**

**Dependent claim 7 describes exemplary computing devices the invention may employ, including a personal computer, cell phone, PDA, and pager (page 7 lines 16-19). Dependent claim 9 describes the further limitation of having the labeled items form a hierarchy (page 4 line 7, page 8 lines 5-11). Dependent claim 14 describes exemplary electronic commerce transactions for which the invention may be employed (page 8 line 19 to page 9 line 6). Dependent claim 15 describes exemplary input devices the invention may use (page 7 line 20 to page 8 line 2).**

#### **(6) Grounds of Rejection to be Reviewed on Appeal**

**(a) Claims 1-2, 6-7, and 14-17 have been rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Pat. No. 6122005 to Sasaki et al. (hereafter "Sasaki") in view of**

**U.S. Pat. No. 5280275 to Kaplan (hereafter “Kaplan”) in further view of U.S. Pat. No. 6868426 to Mankoff (hereafter “Mankoff”).**

**(b) Claims 3-5 and 9 have been rejected under 35 U.S.C. 103(a) as unpatentable over Sasaki in view of Kaplan in further view of Mankoff in further view of Windows NT, 1998, Microsoft, p. 1-4 (hereafter “Windows NT”).**

**(7) Argument**

**(a) As an initial matter, it is noted that according to the Patent Office, a new ground of rejection in an examiner’s answer should be “rare” and should be levied only in response to such things as newly presented arguments by Applicant or to address a claim that the examiner previously failed to address, 69 Fed. Reg. 155 (August 2004), see, e.g., pages 499963 and 49980. Furthermore, a new ground of rejection must be approved by the Technology Center Director or designee and in any case must come accompanied with the initials of the conferees of the appeal conference, id., page 49979.**

**Appellant notes that the supervisory primary examiner signed off on the final rejections. Accordingly it is not expected that reopening of prosecution will occur, since the primary examiner has already had the chance to consider the gravamen of the arguments below and has rejected them.**

**Sasaki teaches generating a pull-down menu in a graphical user interface as the Examiner asserts. However, Sasaki does not allow a user to specify preferences as taught and claimed by the present invention. Instead, Sasaki sorts a list of cameras to be controlled “in accordance with the degrees of frequency of use thereof so that the**

**camera names are displayed in a list in order of decreasing frequency of use.”**

**(abstract, column 9 line 65 to column 10 line 15) Alternately, Sasaki can sort the list of cameras “in order of decreasing time over which the cameras have been selected for control” (column 10 lines 38-40) or “the number of times a camera control command is issued may be counted and the pull-down menu 130 may be displayed in order of decreasing count value” (column 10 lines 42-45).**

**Mankoff teaches a system and method of managing virtual documents, such as virtual coupons that may be used for online ordering. A user may employ a pull-down list to select a vendor for online shopping, according to the section of Mankoff cited by the Examiner. However, Mankoff fails to remedy the shortcomings of Sasaki cited above, e.g. Mankoff also fails to allow a user to specify preferences as taught and claimed by the present invention.**

**Kaplan teaches a graphical user interface that allows users to specify scalar information, such as a numerical rating of a given attribute, using a pointing device (abstract). Kaplan, like Sasaki, denotes that more frequently used items may appear higher in a list of items in a pull-down menu; however this is not a claimed feature here. Kaplan neither teaches nor suggests moving labeled items in pull-down menus such that relative positions of the items correspond to relative user preferences, as described and claimed.**

**In contrast to all cited prior art references, the present invention allows a user to specify preferences regarding available user choices describing electronic commerce transactions by moving labeled items in a pull-down menu, so that relative item positions correspond to relative user preferences. Neither Sasaki nor Mankoff nor**

**Kaplan allow a user to directly specify preferences by moving labeled items in a pull-down menu. Thus, as not all elements of the present invention are taught or suggested by the cited prior art, the obviousness rejections cannot be sustained.**

**Regarding dependent claim 2 specifically, Sasaki teaches the automatic determination of whether power is being supplied to a particular camera. Sasaki then responsively does not display pull-down menu items corresponding to such unpowered cameras, or displays them “such that the user can distinguish the camera from one whose power supply is ON.” (Column 12 lines 44-46). However, Sasaki fails to teach enabling a user to delete items representing unacceptable user choices, as taught and claimed by the present invention (page 4 lines 4 and 9, page 6 lines 20-21). Applicants amended claim 2 to clarify this point. In the Advisory Action, the Examiner asserts that Sasaki teaches a user selecting and deselecting which cameras are active and which are not (column 11 lines 55-65), which “directly results in determining which cameras have power and the resulting list is updated accordingly”. This assertion is not entirely accurate. Sasaki does allow a user to activate and deactivate particular cameras, but this does not remedy its shortcomings with respect to specifying commerce preferences by moving pull-down menu items such that relative positions of the items correspond to relative user preferences.**

**(b) Regarding claims 3-5 and 9, Appellants note the Start Bar in the Windows(R) family of operating systems is well known in the art, but it is not related to arranging items in pull-down menus to specify user preferences regarding electronic commerce transactions as stated in the appealed claims. Thus, the combination of Sasaki and Windows NT fail to each or suggest the present invention, either separately**

or in combination. Mere untaught possibilities are insufficient to defeat patentability.

A prior art reference must be considered in its entirety, i.e., as a whole. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)

For the reasons advanced above, Appellants argue the rejected claims are patentable, thus the rejections merit reversal.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Marc D. McSwain", is written over a horizontal line.

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## **APPENDIX A - APPEALED CLAIMS**

- 1. A method for specifying user preferences, comprising:  
  
generating a pull-down menu in a graphical user interface; and  
  
enabling a user to move labeled items in said pull-down menu representing user  
  
choices describing variables in electronic commerce transactions such  
  
that relative positions of said items correspond to relative user  
  
preferences.**
- 2. The method of claim 1 further comprising a user deleting said items representing  
unacceptable user choices.**
- 3. The method of claim 1 further comprising a user deleting said items representing  
uninteresting user choices.**
- 4. The method of claim 1 further comprising a user limiting the number of said items  
using a cut-off bar.**
- 5. The method of claim 1 wherein said moving further comprises clicking and  
dragging.**



**6. A system for specifying user preferences, comprising:**

**a computing device generating a graphical user interface;**

**a pull-down menu in said graphical user interface including labeled items  
representing available user choices describing variables in electronic  
commerce transactions; and**

**an input device enabling said user to arrange said items such that relative  
positions of said items correspond to relative user preferences.**

**7. The system of claim 6 wherein said computing device is at least one of:**

**a personal computer, a cellular telephone, a personal digital assistant, a pager.**

**9. The system of claim 6 wherein said items form a hierarchy.**

**14. The system of claim 6 wherein said electronic commerce transactions include at  
least one of: making travel reservations, shopping online, choosing a restaurant,  
selecting a vendor, providing marketing data, specifying employment interests.**

**15. The system of claim 6 wherein said input device is at least one of: a mouse, an  
isometric finger-operated computer pointing device, a trackball, a keyboard, a stylus, a  
touch-sensitive screen, a speech analyzer.**

**16. A system for specifying user preferences, comprising:**

**means for generating a pull-down menu in a graphical user interface; and**

**means for enabling a user to move labeled items in said pull-down menu**

**representing user choices describing variables in electronic commerce**

**transactions such that relative positions of said items correspond to**

**relative user preferences.**

**17. A computer program product for specifying user preferences comprising a machine-readable medium tangibly embodying computer-executable code means thereon including:**

**a first code means for generating a pull-down menu in a graphical user interface;**

**a second code means for enabling a user to move labeled items in said pull-down**

**menu representing user choices describing variables in electronic**

**commerce transactions such that relative positions of said items**

**correspond to relative user preferences; and**

**a third code means for processing said specified user preferences.**

## **APPENDIX B - EVIDENCE**

**None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978).**

## **APPENDIX C - RELATED PROCEEDINGS**

**None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978).**